



PATENT
Attorney Docket No. 02481.1768

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Marc NAZARÉ *et al.*) Group Art Unit: 1621
)
Application No.: 10/023,933) Examiner: S. Kumar
)
Filed: December 21, 2001)
)
For: NEW OXYBENZAMIDE)
DERIVATIVES USEFUL FOR)
INHIBITING FACTOR XA OR VIIA)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

This paper responds to the Office Action mailed February 25, 2004, which sets a shortened statutory period for response of one month. In a separate Petition, Applicants have requested and paid the fee for a one-month extension of time. Thus, this response is timely filed by April 25, 2004.

REMARKS

In the Office Action, the Examiner asserts that pending claims 1-21 are directed to 39 allegedly separate and distinct inventions. Applicants are required to elect a single group for examination. In response, Applicants elect Group VX [sic], claims 1-21, drawn to compounds, composition and method of making and method of treating, when any of R0, M, or any other substituent is pyridine, with traverse. Applicants are also required to elect a single species from the elected group. Office Action, page 8. In

response, Applicants elect a compound prepared according to Example 199. See, Specification, pages 173-175.

In traversing the restriction requirement, Applicants draw the Examiner's attention to M.P.E.P. § 803, which sets forth the criteria that the Examiner must satisfy to make a restriction requirement. In particular, the Examiner cannot restrict Applicants' invention unless examination of the claims results in a serious burden. In the present case, the Examiner has not shown that there would be a serious burden to examine at least some of the alleged 39 inventions together in a single application.

The Examiner's only statement concerning a possible burden imposed is that each of the 39 groups "represent divergent chemical groups classified in various groups according to the U.S. classification system." Office Action, page 7. Yet the Examiner has not identified a single class or subclass associated with any of these "divergent chemical groups." Thus, it is not clear to Applicants how the Examiner could have concluded that the compounds encompassed by the claims are classified in different groups. If the Examiner believes there is an undue burden imposed by examining all of the compounds within the claims together, then at the very least, some basis for that belief should be provided on the record. Without such, Applicants have very little ability to properly assess and traverse an excessive restriction requirement.

In the present case, Applicants contend that at least some of the 39 groups may be readily examined together without posing an undue burden. Although the Examiner has decided to split Applicants' invention on the basis of 39 different substituents in the claimed structure, many of these substituents are structurally similar. Thus, a search for

the compounds in one group will overlap with some of the other groups. There would be no burden on the Examiner to examine such overlapping groups as a single invention.

Additionally, Applicants respectfully submit that they have a statutory right under 35 U.S.C. § 112, second paragraph, to claim the subject matter they regard as their invention as they choose. Issuing a restriction requirement within a claim that forces Applicants to carve up that claim and pursue the non-elected subject matter in 39 separate applications violates this right under section 112. Indeed, the C.C.P.A. has characterized such action as tantamount to a refusal to examine. See *In re Weber*, 198 U.S.P.Q. 328 (C.C.P.A. 1978); *In re Haas*, 198 U.S.P.Q. 334 (C.C.P.A. 1978).

In *Weber*, the court warned against the consequences of requiring an applicant to divide up the subject matter presented in a single claim, stating:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

Weber at 331.

The Examiner has provided no substantive reason to justify the violation of Applicants' statutory right under 35 U.S.C. § 112, second paragraph, to claim the subject matter they regard as their invention as they choose.

Accordingly, Applicants respectfully request that the Examiner reconsider the present grouping of claims and rejoin those groups that do not pose a undue burden on the Examiner. Applicants also request that the Examiner identify a proper basis for the restriction of these 39 groups, including a discussion as to why the Examiner believes that each group is patentably distinct from each of the other groups, and why the grouping is necessary to avoid an undue burden on the Examiner. The current Office Action is completely deficient in this regard.


With respect to the election of species requirement, Applicants remind the Examiner that if the elected species is found allowable, pursuant to M.P.E.P. § 803.02, the search must be expanded to encompass the additional species in the claim.

If necessary, please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 7, 2004

By: 
M. Todd Rands
Reg. No. 46,249